

ESTTA Tracking number: **ESTTA603245**

Filing date: **05/08/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215064
Party	Plaintiff Intellectual Reserve, Inc.
Correspondence Address	DALE E HULSE KIRTON MCCONKIE 1800 WORLD TRADE CENTER AT CITY CREEK, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111 UNITED STATES dhulse@kmclaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Michael A. Grow
Filer's e-mail	grow.michael@arentfox.com, bush.doug@arentfox.com, dhulse@kmclaw.com, henrye@arentfox.com
Signature	/Michael A. Grow/
Date	05/08/2014
Attachments	Eller - motion to amend & amended opp.pdf(466717 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 85949670 for MORMON MATCH.

INTELLECTUAL RESERVE, INC.

Opposer

v.

JONATHAN ELLER

Applicant

:
:
:
:
:
:
:
:
:
:

Opp. No. 91215064

OPPOSER'S MOTION FOR LEAVE TO AMEND

Pursuant to Rule 15(a) of the Federal Rules of Civil Procedure, Opposer hereby moves for leave to amend the notice of opposition filed in the above referenced proceeding. An amended notice of opposition is submitted herewith.

The motion is based on the fact that Applicant recently admitted, on May 1, 2014, that he personally does not own the mark at issue in this proceeding, that he did not own the mark when the application was filed and that he has never owned mark. This provides an additional ground for opposition in that it shows that the application is void ab initio. *Am. Forests v. Sanders*, 54 USPQ2d 1860, 1864 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000) (holding an intent-to-use application filed by an individual **void**, where the entity that had a bona fide intention to use the mark in commerce on the application filing date was a partnership composed of the individual applicant and her husband).

Permission for leave to amend a pleading "shall be freely given when justice so requires." Fed. Rule Civ. P. 15(a). In this case, the interests of justice will be served by allowing Opposer to amend its notice of opposition to insert an additional ground for opposition. Applicant's admissions as to lack of ownership were just made and permitting an amendment at

this stage in the proceeding will not cause prejudice to Applicant. In fact, Applicant has not yet filed an answer to the notice of opposition and discovery has not yet started in this case.

Applicant' has filed a motion to dismiss. However, Opposer is simultaneously requesting an extension of time to respond to the motion to dismiss pending a decision on the motion for leave to amend.

Respectfully submitted,

INTELLECTUAL RESERVE, INC.

By



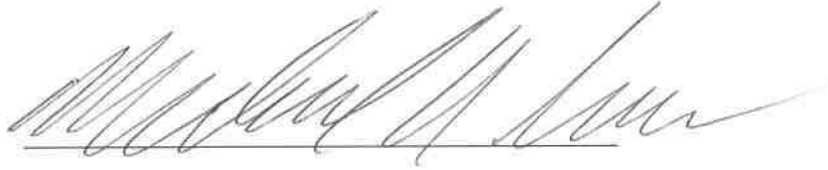
Michael A. Grow
Douglas R. Bush
Arent Fox LLP
1717 K Street, NW
Washington, DC 20036
(202) 857-6000
Bush.douglas@arentfox.com
Grow.michael@arentfox.com

Dale E. Hulse
Kirton McConkie
1800 World Trade Center at City Creek
60 East South Temple
Salt Lake City, UT 84111
801) 321-4815
dhulse@kmclaw.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing is being served on Applicant's counsel Siddartha Rao at 121 E. 12th Street, Apt. LG, New York, New York 10003 by first class mail, postage prepaid on May 8, 2014.

A handwritten signature in dark ink, appearing to be "Michael A. Sun", is written over a horizontal line.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 85949670 for MORMON MATCH

INTELLECTUAL RESERVE, INC.

Opposer

v.

JONATHAN ELLER

Applicant

:
:
:
:
:
:
:
:
:
:

Opp. No. 91215064

AMENDED NOTICE OF OPPOSITION

Opposer Intellectual Reserve, Inc. (“Opposer”) believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Opposer alleges that:

1. Intellectual Reserve, Inc. (“IRI”) is a nonprofit corporation of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City, Utah 84150.
2. IRI owns intellectual property used by The Church of Jesus Christ of Latter-day Saints and its affiliated legal entities, IRI and its affiliates and predecessors being collectively referred to herein as “Opposer.”
3. Opposer is the owner of all right, title and interest in and to the mark MORMON and a family or marks containing the word MORMON (“Opposer's Marks”).
4. The use of Opposer's Marks has been valid and continuous since the respective dates of first use of those marks and such use has not been abandoned.
5. Opposer's Marks have been so used in connection with Opposer’s goods and services that the public has come to associate “MORMON” and its family of MORMON marks

with Opposer, and the marks indicate that the goods and services marketed and/or associated with these marks originate with Opposer.

6. Opposer's Marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through the substantial expenditure of time and resources in promotion and advertising.

7. Opposer's Marks have become well known as distinctive indicators of origin through use on a wide variety of goods and services including educational and counseling services relating to the subject of dating and other educational services, including providing classes, conferences, and institutes in the fields of history, religion, ethics, and moral and religious values; providing on-line religious instruction promoting family values; providing information in the field of parenting concerning education and entertainment of children; providing courses of instruction in the field of marital relations; providing online websites in which individuals may post information about themselves; publications, including books, pamphlets, photographs, instructional and teaching material, posters and prints of paintings; and pre-recorded audio and audio-video discs, entertainment services, textiles and other merchandise.

8. The Patent and Trademark Office has recognized Opposer's exclusive right to use Opposer's Marks by issuing the following registrations:

- Registration No. 3239919, MORMON, issued May 8, 2007
- Registration No. 3715744, MORMON.ORG, issued November 24, 2009
- Registration No. 2883572, BOOK OF MORMON, issued September 14, 2004
- Registration No. 2766231, MORMON TABERNACLE CHOIR, issued September 23, 2003

- Registration No. 2913694, MORMON TABERNACLE CHOIR, issued December 21, 2004
- Registration No. 1524555, MORMON HANDICRAFT, issued February 14, 1989
- Registration No. 1527447, MORMON HANDICRAFT, issued February 28, 1989

9. The foregoing registrations are valid and subsisting and some are incontestable.

Thus, they provide prima facie and conclusive evidence of Opposer's ownership of and exclusive right to use Opposer's Mark in commerce.

10. Since long prior to the filing date of Applicant's application, or any date of first use that Applicant may allege, Opposer's Marks have been the subject of extensive publicity and advertising and Opposer has used and licensed others to use the Marks in interstate commerce in connection with a variety of goods and services.

11. Because of said advertising, publicity and use, Opposer's Marks have become strong and famous and they are entitled to a broad scope of protection.

12. Some of Opposer's Marks have been used since at least as early as 1833.

13. Other marks owned and used by Opposer include, MORMON TIMES, MORMON CHANNEL and MORMON NEWSROOM.

14. On information and belief, Applicant, Jonathan Eller, is an individual doing business as Mormon Match, with an address of 18630 Minden Oaks Drive, Spring, Texas 77388. On June 3, 2013, Applicant filed application Serial No. 85/949,670 for registration of the alleged mark "MORMON MATCH (and Design)" and said application was published for opposition in the Official Gazette of the United States Patent and Trademark Office on October 29, 2013 in

International Class 45 (U.S. Classes 100 and 101) for “Internet-based dating, social introduction and social networking services.” On November 5, 2013, Opposer was granted a 90 day Extension of Time to Oppose, extending the opposition deadline to February 26, 2014.

15. Applicant’s aforesaid application is based upon Applicant’s alleged bona fide intent to use the proposed “MORMON MATCH (and Design)” mark in connection with the above stated services.

16. Upon information and belief, Applicant made no use of its alleged mark in connection with the sale of any products or services prior to the filing date of its application.

17. Upon information and belief, Applicant was aware of Opposer's Marks when Applicant applied to register its alleged mark.

LIKELIHOOD OF CONFUSION - §2(d)

18. The mark that Applicant seeks to register is identical to or so resembles Opposer's Marks that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant’s services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer’s Mark.

19. The services recited in Applicant’s application are similar to goods and/or services presently offered by Opposer, or offered in the past by Opposer, bearing Opposer's Marks.

20. The services of Applicant bearing the alleged mark “MORMON MATCH (and Design)” would pass through the same or similar channels of commerce to the same or similar classes of purchasers as the goods and services offered by Opposer in connection with its MORMON marks.

21. The alleged “MORMON MATCH (and Design)” mark of Applicant, as applied to the services of Applicant set forth in Applicant’s application, so resembles Opposer's Marks, previously used in the United States by Opposer, as applied to the goods and services of Opposer, so as to be likely to cause confusion, or to cause mistake, or to deceive, so as to falsely suggest a connection with Opposer, and so as to dilute the distinctive quality of Opposer's Marks which are believed to be famous.

22. Likelihood of confusion is enhanced in this case by the fame of Opposer's Marks and by the fact that consumers associate Opposer's Marks with goods and services sold, approved or endorsed by Opposer.

23. Likelihood of confusion may be presumed in this case in light of the fact that Applicant obviously adopted an imitation of Opposer's Marks with prior knowledge of Opposer's Marks and with an intent to cause confusion and to capitalize on the popularity of Opposer's Marks.

DECEPTION/FALSE SUGGESTION OF CONNECTION - §2(a)

24. Applicant’s mark so closely resembles Opposer's Marks that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers’ decisions to acquire Applicant’s services.

25. Applicant’s alleged mark so closely resembles Opposer’s Mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant’s alleged mark points uniquely to Opposer and purchasers will mistakenly assume that services sold under Applicant’s alleged mark are connected with Opposer.

26. When Applicant's alleged mark is used on services of the type described in its application, purchasers will mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting the alleged mark to be used on such goods.

27. Applicant's alleged mark is the same as, or is a close approximation of, the name or identity previously used by Opposer.

28. Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to Opposer.

29. Applicant is not connected with Opposer and Opposer is not connected with any activities performed or services offered under Applicant's alleged mark.

30. Opposer's fame or reputation is such that, when Applicant's alleged mark is used with the Applicant's services, a connection with Opposer would be presumed.

31. Applicant's alleged mark is deceptive in that it falsely suggests a connection with, or approval by, Opposer or with institutions or beliefs.

32. Applicant's alleged mark is deceptive in that it falsely suggests a connection with, or approval by, Opposer.

33. Use and registration of the mark MORMON MATCH by Applicant will deprive Opposer of the ability to protect its reputation, persona and goodwill.

34. Likelihood of damage to Opposer's goodwill is enhanced by the fact that prospective customers who encounter defects in the quality of Applicant's services will attribute those defects to Opposer and this will injure Opposer's reputation and goodwill.

DILUTION

35. For many years, Opposer's Marks have been widely used and publicized throughout the United States and, therefore, Opposer's Marks have become well known and

famous as a distinctive symbol of Opposer's goodwill.

36. On information and belief, Applicant intends to use its alleged mark in commerce with a willful intent to trade on Opposer's reputation or to cause dilution of Opposer's famous Marks.

37. Opposer's Marks became well known and famous before Applicant made any use of its alleged mark, and before Applicant filed any application to register its alleged mark. The alleged mark shown in Applicant's application will cause dilution of the distinctive quality of Opposer's Marks.

38. Use or registration of Applicant's alleged mark will lessen the capacity of Opposer's famous Marks to identify and distinguish Opposer's goods and services. Likelihood of confusion, dilution and deception is enhanced by the fact that Applicant's alleged mark is virtually identical to Opposer's Marks.

39. Use and registration of the alleged mark by Applicant will deprive Opposer of the ability to protect its reputation, persona and goodwill.

40. Applicant's use or registration of his alleged mark for the goods and services listed in its applications will tarnish the goodwill symbolized by Opposer's Marks.

41. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by the fact that Opposer has no control over the nature and quality of any goods or services sold under Applicant's alleged mark, and prospective customers who encounter defects in the quality of Applicant's goods or services will attribute those defects to Opposer and this will tarnish Opposer's goodwill.

VOID AB INITIO - §1(b)

42. Applicant has admitted he was not the owner of the mark he seeks to register at the time he filed the application, that he is not now the owner and that he never was the owner.

43. Because Applicant has never been the owner of the mark at issue in this proceeding, the application is void ab initio.


44. As Applicant was not the proper owner of the mark, he did not have a bona fide intent to use the mark as an individual as stated in his application.

45. Because the application was filed in the name of the wrong party, the application cannot be amended to cure the defect.

46. Registration of the Applicant's alleged mark, depicted in application Serial No. 85/949,670, will cause injury and damage to Opposer and the application should be declared void, and the opposition should be sustained.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

INTELLECTUAL RESERVE, INC.

By 

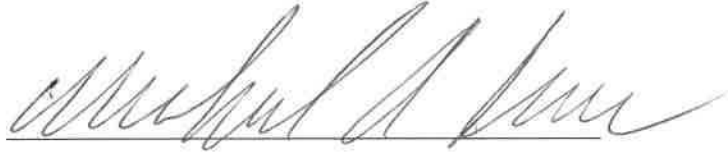
Douglas R. Bush
Michael A. Grow
Arent Fox LLP
1717 K Street, NW
Washington, DC 20036
(202) 857-6000
Bush.douglas@arentfox.com
Grow.michael@arentfox.com

Dale E. Hulse
Kirtan McConkie
1800 World Trade Center at City Creek
60 East South Temple
Salt Lake City, UT 84111
801) 321-4815
dhulse@kmclaw.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing is being served on Applicant's counsel Siddartha Rao at 121 E. 12th Street, Apt. LG, New York, New York 10003 by first class mail, postage prepaid on May 8, 2014.

A handwritten signature in cursive script, appearing to read "Michael A. Dine", is written over a horizontal line.